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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/893,324	06/27/2001	Laszlo Prokai	1540/139	2061

2101 7590 03/04/2002  
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EXAMINER

QAZI, SABIHA NAIM

ART UNIT PAPER NUMBER

1616

DATE MAILED: 03/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/893,324

Applicant(s)

Laszlo et al.

Examiner

Sabiha Qazi

Art Unit

1616



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Jun 27, 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-46 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

Art Unit: 1616

Misnumbered claims 43-45 been renumbered as 43-46. Note, two claims were numbered 43. Claims 1-46 are pending.

***Election/Restriction***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-11 drawn to compounds and pharmaceutical formulations when the polycyclic compound is a four ring compound, containing alkyl ether group at 17 position of the D ring and A ring is aromatic, such as 1, 3, 5(10) triene-3-ol-17-alkyl ether estradiol, classified in class 552, subclass 614; class 514, subclass 182.
- II. Claims 12-25 drawn to method of retarding the development of a degenerative condition associated with a population of cells in a subject when the polycyclic compound is a four ring compound, containing alkyl ether group at 17 position of the D ring and A ring is aromatic, such as 1, 3, 5(10) triene-3-ol-17-alkyl ether estradiol, classified in class 552, subclass 614, 627; class 514, subclass 182.
- III. Claims 26-42 drawn to method of synthesizing estrogen polycyclic compound having four rings containing alkyl ether group at 17 position of the D ring and A ring is aromatic, such as 1, 3, 5(10) triene-3-ol-17-alkyl ether estradiol, classified in class 514, subclass 177, 178, 182.
- IV. Claims 43-46 drawn to method of conferring cytoprotection of a population of cells comprising providing an estrogen polycyclic compound having four rings containing alkyl ether group at 17 position of the D ring and A ring is aromatic, such as 1, 3, 5(10) triene-3-ol-17-alkyl ether estradiol, classified in class 514, subclass 177, 178, 182.

The inventions are distinct, each from the other because of the following reasons:

The inventions of group I-IV are distinct, each from the other because of the following reasons:

The groups I-IV as outlined above are drawn to the invention which require separate searches, and are not art recognized equivalents. The search required for Group I is not required for Group II or any other group. They are patentably distinct. A reference used to reject the invention of one group would not be used for other groups.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art and contains recognized divergent subject matter. The database and other searches for the entire invention would represent excessive burden on the Examiner. The restriction for examination purposes as indicated is proper.

Art Unit: 1616

A telephone call was made to Attorney Harriet M. Strimpel on 2/15/02 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention of a group, and an election of species from the elected group for search purposes, to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventor ship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventor ship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

It is suggested that in order to advance prosecution, the non elected subject matter be canceled when responding to this office action.

***Telephone Inquiry Contacts***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sabiha N. Qazi, whose telephone number is (703) 305-3910. The examiner can normally be reached on Monday through Friday from 8 a.m. to 6 p.m. The fax phone number for this Group is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

2/23/02



**Sabiha N. Qazi, Ph.D.**  
**Primary Examiner**  
**Art Unit 1616**